

YPO-103
(80215-103)



BOX AF

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Akira SUGIYAMA

Serial No. 09/194,051

Filed: March 25, 1999

For: UNIQUE TIME GENERATING
DEVICE AND AUTHENTICATING
DEVICE USING THE SAME

Art Unit: 2161

Examiner: C. Hewitt

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**PETITION UNDER 37 C.F.R. § 1.181
TO REQUEST WITHDRAWAL OF
THE FINAL OFFICE ACTION OF JULY 27, 2001**

BOX AF

Commissioner of Patents
Washington, DC 20231

Sir:

Applicant hereby petitions for withdrawal of finality of the Office Action mailed in the above-identified application on July 27, 2001 as Paper No. 11. This is a petitionable issue because Applicant seeks review of the prematureness of the final rejection within that Office action. MPEP 706.07(c).

Claims 1-39 are currently pending in this application, with claims 1, 2, 4, 5, 23, 24, 27 and 29 being independent.

Claims 1-39 have been finally rejected by the Examiner on July 27, 2001 under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1-7 of U.S. Patent No. 5,933,625 issued to Sugiyama in view of U.S. Patent No. 5,502,765 issued Ishiguro et al. (Ishiguro) and the Examiner's Official Notice.

Because the use of Official Notice is primarily procedural, *In re Ahlert*, 165 USPQ 418, 421 (CCPA 1970), a petition under 37 CFR 1.181 challenging its use in a final rejection of the claims is proper. MPEP 706.07(c).

Background

Office Action of January 17, 2001

Claims 1-39 were rejected by the Examiner on January 17, 2001 under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1-7 of U.S. Patent No. 5,933,625 issued to Sugiyama in view of U.S. Patent No. 5,502,765 issued Ishiguro et al. (Ishiguro) and the Examiner's Official Notice.

The Office Action of January 17, 2001 admits that not all features are taught by the combination of Ishiguro and Sugiyama.

Instead the Office Action of January 17, 2001 contends that "distributive business systems are 'well-known'" without providing a reference in support of this contention.

The Office Action of January 17, 2001 further contends that "it is well-known" that the reduction in computing costs and the increase in processing speed has lead to a paradigm shift away from mainframes" without providing a reference in support of this contention.

The Office Action of January 17, 2001 states that neither Sugiyama nor Ishiguro detail the system in terms of specific commerce applications of an IC or smart card. Yet, the Office Action takes official notice that IC or smart cards that are used in electronic money applications or monetary transactions and that interact with gaming, banking or travel computers systems are well known in the art without providing a reference in support of this contention.

Amendment and Request for Reconsideration of Office Action
of January 17, 2001

The double patenting rejection made within the Office Action of January 17, 2001 was respectfully traversed in the Amendment and Request for Reconsideration filed on July 16, 2001.

Regarding the double patenting rejection, the Amendment and Request for Reconsideration highlighted the admissions made within the Office Action of January 17, 2001 that all of the claimed features are not disclosed, taught or suggested by the combination of Ishiguro and Sugiyama.

The Amendment and Request for Reconsideration traversed the assertions made within the Office Action of January 17, 2001 of Official Notice or what is well known, and requested a reference or Examiner's affidavit to support the officially noticed position of obviousness or what is well known. Section 2144.03 of the Manual of Patent Examining Procedure, 7th Edition, July 1998, sets forth the propriety of such a request.

The Amendment and Request for Reconsideration additionally requested the withdrawal of the Official Notice or assertions of

what is well known if a reference or Examiner's affidavit is not provided.

Final Office Action mailed on July 27, 2001

The Final Office Action mailed on July 27, 2001 maintained the rejection of claims 1-39 under the judicially created doctrine of obviousness-type double patenting made within the Office Action of January 17, 2001.

Instead of providing a reference or Examiner's affidavit to support the officially noticed position of obviousness or what is well known, the Final Office Action contends that:

"Regarding the Official Notices, in Europe, smart cards are very popular within the banking industry. For example, French banks began issuing these cards around 1984. Attorneys use personal computer software applications to draft correspondences with the USPTO. Within a firm, an attorney has a word or data processing application running on his or her desktop. This is not possible before the shift away from mainframes where the application would instead be stored on a central computer." (Final Office Action at page 2).

Arguments

As a rule, "assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference." (Citations omitted). *In re Pardo and Landau*, 214 USPQ 673, 677 (CCPA 1982).

"Allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge." (Citations omitted). *In re Pardo and Landau*, 214 USPQ 673, 677 (CCPA 1982).

The support must have existed at the time the claimed invention was made. *In re Merck & Co., Inc.*, 231 USPQ 375, 379 (Fed. Cir. 1986).

Although the Final Office Action rejects the claims under the judicially created doctrine of obviousness-type double patenting, the Final Office Action is replete with statements regarding what Sugiyama and Ishiguro fail to teach. To make up

for these deficiencies, the Final Office Action submits unsupported assertions to what was well known. However, these unsupported assertions amount to nothing more than conclusions that are personal in nature.

The teachings, suggestions or incentives supporting the obviousness-type double patenting rejection must be clear and particular. Broad conclusory statements, standing alone, are not evidence. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Moreover, the procedures established by Title 37 of the Code of Federal Regulations expressly entitle the Applicant to an Examiner's affidavit upon request. Specifically, "when a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons." 37 CFR 1.104(d)(2).

In addition, the failure to provide any objective evidence to support the challenged use of Official Notice constitutes clear and reversible error. *Ex parte Natale*, 11 USPQ2d 1222, 1227-1228 (Bd. Pat. App. & Int. 1989).

Objective evidence or an Examiner's affidavit to support the use of Official Notice or what is well known has been previously requested in the Amendment and Request for Reconsideration filed on July 16, 2001. However, the requested evidence or affidavit has not been forthcoming.

Therefore, Applicant submits that the Examiner's grounds for making the final rejection of claims 1-39 under the judicially created doctrine of obviousness-type double patenting is both improper and unreasonable.

"If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection." MPEP 706.07(d).

Accordingly, Applicant hereby petitions the Commissioner under 37 CFR 1.181 to direct the examiner to withdraw the

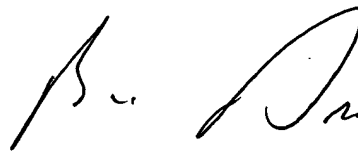
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finality of the Office Action mailed in the above-identified application on July 27, 2001 as Paper No. 11.

No fee is believed required to support this petition. See 37 CFR 1.181. However, if a fee is required, the Commissioner is hereby authorized to charge the fee to Deposit Account # 18-0013.

Respectfully submitted,



DATE: September 7, 2001

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